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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,751	02/23/2004	Timothy Daniel Kostar	13DV-14085 (07783-0113)	2241
31450 7590 07/28/2008 MCNEES WALLACE & NURICK LLC 100 PINE STREET P.O. BOX 1166 HARRISBURG, PA 17108-1166				
EXAMINER				
MATZEK, MATTHEW D				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
07/28/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/784,751

**Applicant(s)**

KOSTAR ET AL.

**Examiner**

MATTHEW D. MATZEK

**Art Unit**

1794

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 3-5, 8-20 and 28-31.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Arti Singh/  
Primary Examiner, Art Unit 1794

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that just because the references can be combined or modified does not render the resultant obvious unless the prior art suggests the desirability of the combination. Examiner has relied upon Hillig et al. for the motivation to combine the two references to arrive at the claimed invention. Applicant argues that if the proposed modification or combination of the prior art would change the principle or operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. The combination of Tani and Hillig does not change the principle or operation of the prior art invention of Tani as both references are directed to ceramic composites concerned with toughness. Applicant argues that not all of the claimed limitations are provided for the in combination of the applied prior art. In particular, Applicant asserts that since the chopped fibers of Hillig are dried and then impregnated they serve to solve a different purpose than that of Applicant. Examiner has not relied upon the chopped fiber structure of Hillig to modify Tani, rather the use of chopped fibers of Hillig to make the nonwoven taught by Tani, which would serve to solve issues pertaining to minimizing voidage in the composite and improve its toughness. A holding of obviousness can be based on a showing that there was "an apparent reason to combine the known elements in the fashion claimed." KSR, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. In other words, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). However, this reasoning is not limited to the problem the patentee was trying to solve; "any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed," KSR, 127 S. Ct. at 1742, 82 USPQ2d at 1397 (emphasis added). Applicant argues that one of ordinary skill would not look to Hillig to modify Tani, because Hillig does not use preforms, but rather individual fibers. While Hillig may use individual fibers over preforms, the issue of decreased strength between continuous fiber layers would necessarily be present in both inventions and the use of the chopped fiber would alleviate working strain for the composite prior to matrix failure and reserve strength should such matrix failure occur. Applicant argues that there is no reasonable expectation of success when combining the chopped fibers of Hillig into the invention of Tani. As Examiner has pointed out earlier, he has relied upon the Hillig for the teaching of chopped fibers, but is using the chopped fibers in the nonwoven of Tani that is pre-existing. Applicant argues that even if the chopped fibers of Hillig are used to form a nonwoven prepreg of Tani it still fails to provide for "a compressed nonwoven mat". As pointed out in the rejection section of the previous Final Office action, The limitation of using a "compressed nonwoven mat" between the preform lamina is met by the applied art in that the structure and composition of the claimed article is provided by Tani and Hillig et al. and the "compressed" limitation would not materially affect the structure of the claimed nonwoven mat that is already very thin or distinguish it from the mat of Hillig et al. (0.02" thick). Furthermore, the articles disclosed in Tani and Hillig et al. are laminated, which results in a "compressed" nonwoven. Applicant argues that even if the chopped fibers of Hillig are used to form a nonwoven prepreg of Tani it still fails to substantially remove the interface between the adjacent preform lamina. As demonstrated in the rejection section of the Final Rejection, the disclosure of Tani provides for at least one nonwoven layer between the adjacent preform lamina and this would remove the interface between adjacent preform lamina because it would have a chopped fiber layer between said adjacent preform lamina. The combined disclosures provide for nonwoven layers of the claimed thickness and as such would necessarily remove the interface between the adjacent preform lamina and the "compressed" limitation. Applicant is encouraged to structurally distinguish the claimed invention's "compressed" nonwoven and that of the applied prior art. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).